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Paper No. 14

In re Application of	:	DECISION ON PETITION
Frank E. Joutras et al	:	UNDER 37 CFR 1.144 TO
Serial No. : 09/379,851	:	REVIEW RESTRICTION
Filed : August 24, 1999	:	REQUIREMENT
For : Exercise Apparatus and Technique	:	

This is a decision on the petition filed December 31, 2001, that is being treated as a petition under 37 CFR 1.144, requesting the withdrawal of an alleged improper requirement for restriction. In the instant application, an election of species and a restriction requirement were made. Applicant responded to both with an election and a traversal. The examiner considered the traversals and made the requirements final. Subsequently, applicant filed the instant petition to have the restriction requirement withdrawn. There is no fee required for this petition.

A careful review has been made of the entire application and of the various points raised by petitioner with respect to the election requirements. No clear error has been found in the examiner's position to warrant withdrawal of the restriction requirements.

BACKGROUND

The instant application was filed August 24, 1999 with claims 1-7.

In an Office action mailed October 11, 2000, applicant was required to elect a single disclosed species from the following groupings:

Species A	Figure 3;
Species B	Figures 5-6;
Species C	Figure 19;
Species D	Figure 42;
Species E	Figures 60-65;
Species F	Figure 74;
Species G	Figure 78;
Species H	Figure 97; and
Species I	Figure 99.

Applicant was required to identify the species elected and list all claims readable thereon.

On January 8, 2001, applicant filed a paper titled "Amendment" amending claim 2, and adding claims 8-24. Also, applicant elected, with traverse, Group or Species D and identified claims 1-8 as either being

generic or as reading on the elected species. Applicant provided arguments as to why the requirement for election of species was improper and requested withdrawal of the requirement.

On, March 27, 2001, in view of the addition of claims 8-24, restriction to one of the following groupings was required:

- I. Claims 1-12, drawn to an orthotic, classified in class 602, subclass 5;
- II. Claims 13-19, drawn to a method of reducing arthrokinetic dysfunction, classified in class 601, subclass 33; and
- III. Claims 20-24, drawn to a method of aiding a person in physical activity, classified in class 482, subclass 5.

The examiner, as required by MPEP 803, provided a showing that the inventions were independent or distinct and that examination of the entire application would impose a serious burden on the examiner.

On April 27, 2001, applicant filed a paper titled "Election with Traverse" and elected, with traverse, Group I. Applicant, as it was done in response to the previous election of species requirement, provided arguments as to why the requirement for restriction was improper and requested withdrawal of the requirement.

On July 12, 2001, the examiner acknowledged the election and issued an Office action acting on claims 1-12. The examiner considered the arguments presented with the elections made January 8, 2001 and April 27, 2001, and made both requirements final giving reasons as to why the traversals were not deemed persuasive. Claims 13-24 were indicated as being withdrawn from consideration.

On October 15, 2001 (certificate of mailing dated October 12, 2001), applicant filed a response to the Office action of July 12, 2001.

On December 31, 2001, the instant petition was filed.

On January 2, 2002 a final Office action, rejecting claims 1-12 was mailed to applicant. The action once again indicated that claims 13-24 were withdrawn from consideration.

DISCUSSION

Initially, it is noted that all of the arguments presented in the petition are directed strictly to the restriction requirement made March 27, 2001. Accordingly, the absence of any arguments relative to the election of species requirement made in the Office action mailed January 8, 2001 is taken as acquiescence to that requirement.

As indicated before, there are two criteria that must be met if a proper restriction requirement is to be made. As set forth in MPEP 803, the inventions must be independent or distinct and there must be a serious burden on the examiner if restriction is not required.

In the restriction requirement of March 27, 2001, the examiner demonstrated distinctness between Groups I and II and between Groups I and III by relying on the procedure set forth in MPEP 806.05(e) – Process and Apparatus for its Practice. Under these guidelines, a process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown; (1) that the process **as claimed** can be practiced by another materially different apparatus or by hand; or (2) that the apparatus **as claimed** can be used to practice another and materially different process (emphasis added). The examiner showed distinctness by setting forth that the process, as claimed, could be practiced by another materially different apparatus, such as an apparatus that does not include a jointed limb brace or one that does not include a friction means. Although not required, the examiner also showed distinctness by setting forth that the apparatus can be used to practice a method of strengthening joints or limiting movement, materially different processes than a method of reducing arthrokinetic dysfunction or of aiding in physical activity. In addition, the examiner held that the inventions of Groups II and III are unrelated and provided the showing that is required by MPEP 806.04 and 808.01. Finally, the examiner complied with the second criteria by indicating that the inventions of Groups I, II, and III had acquired a separate status in the art required diverging searches.

In the petition filed December 31, 2001, petitioner argues that the methods of claims 13-24 can only be practiced using the apparatus of claims 1-12. However, petitioner presents no arguments to challenge (1) the examiner's assertion that the apparatus as claimed can be used to practice another and materially different process, or (2) the assertion that the inventions of Groups II and III are unrelated, or (3) that the inventions of Groups I, II, and III had acquired a separate status in the art and required diverging searches. Inasmuch as the required showing under MPEP 806.05(e) is in the alternative, that is, the examiner's position that the apparatus as claimed can be used to practice another and materially different process coupled with the showing under MPEP 806.04 and 808.01 that inventions II and III are unrelated and the indication that the inventions have acquired a separate status in the art and require diverging searches constitutes a complete restriction requirement, the omission of the items noted above alone provides sufficient grounds for the denial of the instant petition. Nevertheless, the position advanced by petitioner in seeking withdrawal of the restriction requirement will be addressed herein below.

The only argument advanced by petitioner is that the process recited in method claims 13-24 cannot be practiced with an apparatus other than the orthotic apparatus of claim 1, which recites a joint. Petitioner states that the "methods and apparatuses are both used for the same purpose and indeed, use the claimed apparatus." It is argued that the jointed limb brace limitation that is specifically recited in apparatus claim 1 is inherent to the method recited in claims 13-24. Petitioner states that an apparatus that does not include the jointed limb brace cannot practice the recited methods.

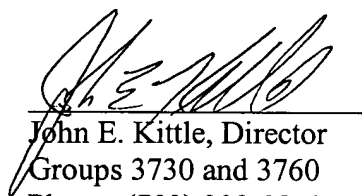
In response to the position taken by petitioner, it is noted that the methods **as claimed** do not require the use of a jointed limb brace. None of the method claims include a limitation that calls for the use of a jointed limb brace. The methods, as claimed, can be practiced by using an exercise machine, a strap, or by hand. Further, the methods, as claimed can be performed using limb braces that are not jointed, such as by devices that provide support for areas of the body that do not include a joint, while allowing jointed areas to be free of support. Finally, as stated in the paragraph bridging pages 2 and 3 of the petition, arthrokinetic dysfunction means that ordinary movement of body portions about a joint results in pain or inflammation. A method to reduce this dysfunction might require that normal joint movement be

prevented. As such, the method of claims 13-19 does not inherently require a "jointed limb brace". Likewise, the method of aiding a person in physical activity (claims 20-24) could be a process of performing isometric exercises, which does not require a jointed limb brace. By performing isometric exercise, muscles are strengthened. Strengthening of muscles is a method of aiding a person in physical activity.

For the reasons enumerated above, the restriction requirement of March 27, 2001 is considered to be proper and therefore, maintained.

It is noted that a one-month extension of time to respond to the Office action of January 2, 2002 was filed April 11, 2002 (certificate of mailing dated April 1, 2002), a Notice of Appeal was filed May 13, 2002 (certificate of mailing dated May 2, 2002), and a Brief on Appeal was filed July 8, 2002 (certificate of mailing dated July 2, 2002). Thus, upon the mailing of this decision, the application will be forwarded to the Examiner for consideration of the above noted papers.

Summary: Petition to withdraw the restriction requirement made March 27, 2001 denied.



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